

REMARKS

Claims 1 and 3-47 are pending in this application after this Amendment. Claims 1, 19, 27, and 30 are independent. Claim 2 has been cancelled without prejudice or disclaimer. Claims 22-47 have been added. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to the specification and objected to claims 4-18. The Examiner additionally rejected claims 1-3 and 19-21 under 35 U.S.C. § 102(e) as being anticipated by *Taguchi et al.* (USP 5,748,808). Applicants respectfully traverse these rejections.

Objection to the Specification

The Examiner objected to the incorporation of Swedish Patent Application No. 9704924-1, asserting it is essential material. Applicants respectfully disagree with the Examiner's objection.

First, in the Applicants' specification on page 13, line 17, Applicants list the corresponding U.S. application number to the Swedish patent application number. Assuming, *arguendo*, that this information is essential, an application for a patent when filed may incorporate "essential material" by reference to 1) a U.S. patent, 2) a U.S. patent application publication, or 3) a pending U.S. application. *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). As the Applicants provided the corresponding U.S. application

number, now amended to recite the corresponding U.S. patent Number, it is respectfully submitted that the outstanding objection be withdrawn.

Second, it is respectfully submitted that essential material is defined as that which is necessary to 1) describe the claimed invention, 2) provide an enabling disclosure of the claimed invention, or 3) describe the best mode. As the description of the Swedish patent application number and corresponding U.S. application number were described as an alternative way of matching the images in order to find the best overlap position, it is respectfully submitted that the materials incorporated by reference do not qualify as essential material. Based upon the reasons set forth above, it is respectfully requested that the outstanding objection be withdrawn.

Claim Objections

The Examiner objected to claims 4-18 under 37 C.F.R. § 1.75(c) as being in improper multiple dependent claim format. By this Amendment, Applicants have amended these claims to be written in proper U.S. claim format. Based upon these claim amendments, it is respectfully requested that the Examiner consider these claims.

Claim Rejections - 35 U.S.C. § 102(e)

By this Amendment, Applicants have amended the claims to more appropriately recite the present invention. It is respectfully submitted that these claim amendments are being made without

conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

The disclosure set forth in *Taguchi et al.* is directed to an imagery producing method and apparatus capable of storing and reproducing handwriting. *Taguchi et al.* discloses a handwriting storing and reproducing method which takes small images including a leading edge for writing and stores the small images in a time sequential manner following a movement of a writing device. The method then reads out the stored small images and overlaps a just read out small image to a previously read out small image so as to obtain a partial image when both small images include portions which include partial handwritings coincident to one another. Thereafter, the method overlaps one partial image to another partial image so as to obtain a larger image when both partial images include portions which include partial handwritings coincident to one another (Abstract).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a device for recording handwritten information comprising image processing means adapted to determine the relative positions of the images with the aid of the partially overlapping contents for providing a description in digital format of how the recording means have been moved and to store the handwritten information by storing the description of how the recording means have been moved. It is respectfully submitted that the imagery

producing method and apparatus of *Taguchi et al.* provides for storing the small images in a time sequential manner following the movement of a writing device. There is no disclosure in *Taguchi et al.* that teaches or suggests storing the handwritten information by storing the description of how the recording means have been moved. Thus, as *Taguchi et al.* fails to teach or suggest all of the elements as set forth in claim 1, it is respectfully submitted that claim 1 is not anticipated by *Taguchi et al.* It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3-18 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

It is further respectfully submitted that claim 19 recites, *inter alia*, storing the handwritten information by storing the description of how the device has been moved. As noted above, *Taguchi et al.* fails to teach or suggest this claimed element. As such, it is respectfully submitted that claim 19, together with claims dependent thereon, are not anticipated by *Taguchi et al.*

In support of the Examiner's rejection of claim 21, the Examiner merely recites that his description with regard to claim 1 is sufficient to show *prima facie* anticipation of claim 21. Applicants respectfully disagree with the Examiner's assertion. It is respectfully submitted that claim 21 is directed to a method of determining a position of a hand-held device while the invention of

claim 1 is directed to a device for recording handwritten information. Claim 21 additionally recites, *inter alia*, determining the relative position of the images and using the relative positions for determining the position of the device. It is respectfully submitted that the Examiner has failed to provide any support in his rejection for the teachings of these claimed elements. As the Examiner has failed to provide a *prima facie* case of anticipation under 35 U.S.C. § 102, it is respectfully requested that the outstanding rejection be withdrawn.

Additionally, it is respectfully submitted that *Taguchi et al.* fails to teach or suggest these claimed elements as set forth in claim 21. *Taguchi et al.* teaches obtaining a positional relationship between an act and a scene by performing a matching operation. Specifically, *Taguchi et al.* teaches at col. 18, lines 6-16 as follows:

When a movement vector of the lead 2 is obtained from position data of the lead 2 when the act was reproduced from cells, and an actually written handwriting within the act is removed based upon the movement vectors, a handwriting remains which was previously written. Hereinafter, the handwriting is referred to as the existing handwriting. The existing handwriting should exist in one of previously reproduced scenes. Therefore, the positional relationship of a scene and an act which include the existing handwriting in common is detected, then the act and scene are overlapped to one another.

However, there is no teaching or suggestion in *Taguchi et al.* that is directed to using the relative positions for determining the

position of the device. *Taguchi et al.* merely teaches obtaining a positional relationship between an act and a scene by performing a matching operation utilizing the movement vectors. However, there is no teaching or suggestion in *Taguchi et al.* that is directed to determining the position of the device. As the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. § 102. It is respectfully requested that the outstanding rejections be withdrawn.

By this Amendment, Applicants have added new claims 30-47. It is respectfully submitted that claim 30 contains elements similar to those discussed above with regard to claim 1 and, thus, it is respectfully submitted that claim 30, together with claims dependent thereon, are not anticipated by *Taguchi et al.*

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

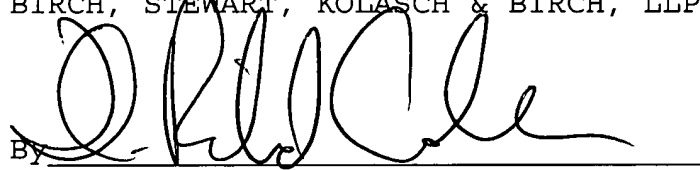
Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the

amount of \$110.00 in payment of the extension of time fee is attached.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

A handwritten signature in black ink, appearing to read "D. Richard Anderson", is written over a horizontal line.

D. Richard Anderson, #40,439


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